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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,257	01/16/2002	Mutsumi Matsumoto	1341.1118	3568
21171 7590 08/19/2008 STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER DESHPANDE, KALYAN K	
			ART UNIT 3625	PAPER NUMBER
			MAIL DATE 08/19/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/046,257

**Applicant(s)**

MATSUMOTO, MUTSUMI

**Examiner**

Kalyan K. Deshpande

**Art Unit**

3625

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1.4.7.9 and 12-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1.4.7.9 and 12-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Introduction***

The following is a non-final rejection based on communications received on June 4, 2008. Claims 1, 4, 7, 9, 12-16 are pending in the instant application.

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 4, 2008 has been entered.

### ***Response to Amendments***

Applicants' amendments to claim 1, 7, 9, and 13-14 are acknowledged. New claim 16 is acknowledged.

### ***Response to Arguments***

Applicants' arguments have been fully considered but are moot in view of the new ground(s) of rejection. Applicants further argue the claims as amended and as such a discussion of the rejections is below.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter.

Claims 1, 4, 13-14, and 16 recite methods which fail to (1) be tied to another statutory class and (2) transform underlying subject matter. Although the present invention recites the use of a "delivery goods management apparatus", this is just the nominal recitation of a physical structure and fails to satisfy the statutory requirements. Likewise, claims 13-14 recite a "method in a data processing system" and a "method of operating a data processing system", and these are just a nominal recitation of a physical structure and fails to satisfy the statutory requirements. See *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). Furthermore, no transformation of any physical object is completed during the recitation of the present invention. As such, the present invention is directed towards non-statutory subject matter and is rejected under 35 U.S.C. 101.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

**Claims 1, 4, 7, 9, and 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moreno (Patent Application Publication No. 2002/0035515 A1) in view of Saki et al. (U.S. Patent No. 7,174,307).**

Moreno claims priority to provisional application 60/218,400 filed on July 14, 2000. Said provisional application provides 35 U.S.C. 112, first paragraph support for paragraphs 0001 – 0081 of the Moreno reference. Said provisional application does not provide 35 U.S.C. 112, first paragraph support for paragraphs 0082 - 0112 of the Moreno reference, therefore those sections of Moreno do not qualify as prior art.

As per claim 1, Moreno discloses a method of and apparatus for managing delivery goods when directly delivering goods from a deliverer (Moreno: paragraph 0053, "Depending upon the vendor providing the goods/services, delivery may be obtained by a designated deliverer, by a commercial deliverer, or by another entity.") to a location associated with a recipient (Moreno: paragraph 0053, "Next, the process continues with delivering the goods/service to the locker...") comprising:

- Receiving, at a delivery goods management apparatus, a request to confirm reception of delivery goods entered by a deliverer when a recipient of the delivery

goods from the location is absent approves or rejects delivery of the goods by the deliverer to the location (Moreno: paragraphs 0064 through 0065, "Upon arriving at the storage unit, the carrier appropriately provides the designated tracking code, access code, or other required verifications...");

- Extracting recipient information from a storage unit of the delivery goods management apparatus, where the storage unit stores the recipient information corresponding to information related to the request to confirm reception of the delivery goods (Moreno: paragraph 0066, "Upon delivering /picking-up the goods and securing the locker, the system then notifies the server..."); and
- Transmitting a notification, from the delivery goods management apparatus, to said recipient of confirmation request information based on the recipient information while the recipient is absent from the location (Moreno: paragraph 0066), said method further comprising:
  - Further storing information for a deliverer corresponding to delivery goods identification information in said storage unit and receiving the delivery goods identification information and reception approval information entered by said recipient (Moreno: paragraph 0067);
  - Extracting the deliverer information relevant to the delivery goods identification information from said storage unit (Moreno: paragraph 0067); and
  - Notifying said deliverer of the reception approval information based on the deliverer information (Moreno: paragraph 0067).

The Examiner notes, the claims require the recipient to confirm as to whether the recipient approves or rejects delivery. The claims are written utilizing alternative language, and accordingly, once a positively recited step is satisfied (i.e., either approving or rejecting), the method as a whole is satisfied - regardless of whether or not other steps are conditionally invocable under certain other hypothetical scenarios.

Moreno fails to explicitly teach the features of "wherein the request includes a message to confirm as to whether the recipient approves or rejects delivery of the goods by the deliverer to the location" and "so that the deliverer delivers the goods when a result of the reception approval/refusal indicates an approval of the delivery of the goods by the recipient". Sakai, in an analogous art, explicitly teaches "wherein the request includes a message to confirm as to whether the recipient approves or rejects delivery of the goods by the deliverer to the location" (Sakai: column 7 lines 46-67 and column 8 lines 1-5; where the flag is the same thing as a notification of approval/rejection) and "so that the deliverer delivers the goods when a result of the reception approval/refusal indicates an approval of the delivery of the goods by the recipient" (Sakai: column 7 lines 46-67 and column 8 lines 1-5; "Rejection flag denotes a flag...showing that a gift is to be sent from a sender to a receiver is rejected before the gift is actually delivered to the receiver"). The advantage of such features is that they ensure the proper delivery of items, thereby increasing the accuracy of the method. It would have been obvious, at the time of the invention, to one of ordinary skill in the art to combine these features taught by Sakai to Moreno in order to increase the accuracy of the method.

As per claim 4, Moreno teaches "further storing information for a client corresponding to the delivery goods information in said storage unit, and extracting the delivery goods information and client information relevant to the delivery goods identification information, from said storage unit" (Moreno: paragraph 0067). Moreno fails to explicitly teach "notifying said client of the reception approval/refusal information based on the client information". Sakai, in an analogous art, explicitly teaches this feature in column 7 lines 46-67 and column 8 lines 1-5, where approval/refusal information is stored as a flag with the client information. The advantage of such a feature is again to improve the accuracy of the deliveries thereby increasing the accuracy of the method. It would have been obvious, at the time of the invention, to one of ordinary skill in the art to combine this feature taught by Sakai to Moreno in order to improve the accuracy of the method.

Claims 7, 9, and 12-16 recite a "delivery goods management apparatus", a "computer readable storage medium", a "method in a data processing system", and a "method of operating a data processing system" taught by Moreno (see Moreno abstract). Claims 7, 9, and 12-16 further recite limitations already addressed by the rejections of claims 1 and 4; therefore the same rejections apply to these claims. Examiner notes that claim 16 recites a broaden method of claim 1.



***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kalyan K. Deshpande whose telephone number is (571)272-5880. The examiner can normally be reached on M-F 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on (571) 272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/KALYAN DESHPANDE/

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